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ART UNIT	PAPER NUMBER
2167	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/711,954	DANIELS ET AL.
	Examiner	**Art Unit**	
	Mariela D. Reyes	2167	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 May 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21 and 28-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21 and 28-32</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>15 October 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May

22nd, 2007 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

According to MPEP 2106.1:

When nonfunctional descriptive material is recorded on some computer-

readable medium, in a computer or on an electromagnetic carrier signal, it is not

statutory since no requisite functionality is present to satisfy the practical

application requirement. Merely claiming nonfunctional descriptive material, i.e.,

abstract ideas, stored in a computer-readable medium, in a computer, on an

electromagnetic carrier signal does not make it statutory. See Diehr, 450 U.S. at

185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were

unpatentable as abstract ideas because "[t]he sole practical application of the

algorithm was in connection with the programming of a general purpose

computer.").

Claims 28-32 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Applicant's specification recites in page 11 that

"...the computer readable medium could be paper..." this renders the claims non-

statutory because the fact that the instructions are stored in the computer readable

medium doesn't requisite that the functionality of the instructions be present.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Barrett et al (US Patent 5,727,129) in view of Goldstein et al (US PG Pub

2003/0221167).

With respect to independent claim 1:

Barrett teaches:

A method to identify a previously visited URL in results from a search,

comprising:

Loading a URL personal databook collection (profile) **object** (Column 7 Lines

26-28, discloses that the profile will processed therefore it had been loaded) **in**

response to receiving the results of a network search by the search engine

(Column 3 Lines 63-65, discloses receiving results from a query executed by a user in a search engine); **and**

Identifying any matches between results from the search and any URL object references of previously visited URLs in the URL personal databook collection (profile) **object.** (Column 7 Lines 57-65, discloses processing the profile to identify the previously visited URLs matching the search results)

Presenting any URL references that have been previously visited by a user. (Column 8 Lines 52-56, discloses presenting to the user the URL results of previously visited sites)

Barrett doesn't appear to explicitly disclose **entering at least one search term in a search engine, selectively saving URL references that have been previously visited and presenting all search results that satisfy at least one search term including any URL references that satisfy the at least one search term but have not been previously visited by the user and therefore have not been saved in the URL personal databook collection object.**

Goldstein teaches **entering at least one search term in a search engine** (Paragraph [033], teaches entering a search term in a search engine) **selectively saving URL references that have been previously visited** (Paragraph [0134], discloses that a user will be able to selectively add previously visited web pages to their favorites) **and presenting all search results that satisfy at least one search term including any URL references that satisfy the at least one search term but have not been previously visited by the user and therefore have not been saved in the**

URL personal databook collection object. (Paragraph [0034], discloses returning a

list of web pages related to the search term entered by the user, this would allow users

to not only receive pages that have already been visited by them, but also pages that

may be relevant but haven't been already visited.)

It would be obvious for someone with ordinary skill in the art at the time of the

invention to combine the teachings of the cited references to implement **entering at**

least one search term in a search engine, selectively saving URL references that

have been previously visited and presenting all search results that satisfy at least

one search term including any URL references that satisfy the at least one search

term but have not been previously visited by the user and therefore have not

been saved in the URL personal databook collection object because this would

allow users to not only receive pages that have already been visited by them, but also

pages that may be relevant but haven't been already visited.

With respect to claim 2:

Barrett teaches **comparing the results from the search to any URL object**

references in the URL personal databook collection object to identify any

matches. (Column 7 Lines 57-65, discloses processing the profile to identify the

previously visited URLs matching the search results)

With respect to claim 3:

Barrett teaches **visually identifying any matches in the results from the search.** (Column 8 Lines 54-56, discloses identifying the matches by presenting the URLs)

With respect to claim 4:

Barrett teaches **visually identifying any matches by at least one of a predetermined icon, a predetermined text font and highlighting.** (Column 8 Lines 66-67, discloses that the predicted links (applicant's matches) may be represented as icons or be shown as highlighted or colored)

With respect to claim 5:

Barrett teaches **presenting any saved or captured comments** (Column 8 Lines 56-57, discloses that while presenting the information also statistics (applicant's comments will be presented) **associated with any matches in response to positioning a computer pointing device on a selected visually identified match in the results from the search,** (Column 8 Lines 63-65, discloses that the access to the URLs is facilitated by using mouse clicks) **wherein the saves or captured comments are presented on a page displaying the search results.** (Column 8 Lines 56-57, discloses that while presenting the information also statistics (applicant's comments will be presented)

With respect to claim 6:

Barrett teaches **selecting any results from the search containing content of interest for future reference in response to no matches.** (Column 7 Lines 50-55, discloses that the pages stored in the profile (applicant's URL personal databook) are pages that have been previously visited by the user, therefore a user can add a web page to the profile by visiting the web page)

With respect to claim 7:

Barrett teaches **storing only search results selected by a user in the URL personal databook collection** (profile) **object.** (Column 7 Lines 50-55, discloses that the selected by visiting URLs will be stored in the profile)

With respect to claim 8:

Barrett teaches **storing the selected search results comprises storing a URL reference.** (Column 7 Lines 50-55, discloses that the selected matches are stored in URL form)

With respect to claim 9:

Barrett teaches **storing the URL reference as a serialized object.** (Column 7 Lines 56-65, discloses that the URL reference are stored with their related statistics)

With respect to claim 10:

Barrett teaches **storing any comments in association with the stored search results.** (Column 8 Lines 56-57, discloses that the information pertaining to statistics for each URL are shown, therefore it would be inherent that they would be stored)

With respect to claim independent 11:

Barrett teaches:

A method to identify a previously visited URL in results from a search, comprising:

Presenting all search results that satisfy the at least one search term; (Column 8 Lines 52-56, discloses presenting to the user the URL results of previously visited sites)

Comparing the results from a network search by a search engine (Column 3 Lines 63-65, discloses receiving results from a query executed by a user in a search engine) **to any URL object references of previously visited URLs in a URL personal databook collection (profile) object** (Column 7 Lines 26-28, discloses that the profile (applicant's personal databook collection) will processed and Column 7 Lines 57-65, discloses processing the profile to identify the previously visited URLs matching the search results); **and**

Visually identifying any matches between the results from the search and any URL object references in the URL personal databook collection (profile) object. (Column 7 Lines 57-65, discloses processing the profile to identify the previously visited URLs matching the search results)

Barret doesn't appear to explicitly disclose **entering at least one search term in a search engine, selectively saving URL references that have been previously visited and presenting all search results that satisfy at least one search term including any URL references that satisfy the at least one search term but have not been previously visited by the user and therefore have not been saved in the URL personal databook collection object.**

Goldstein teaches **entering at least one search term in a search engine** (Paragraph [033], teaches entering a search term in a search engine) **selectively saving URL references that have been previously visited** (Paragraph [0134], discloses that a user will be able to selectively add previously visited web pages to their favorites) **and presenting all search results that satisfy at least one search term including any URL references that satisfy the at least one search term but have not been previously visited by the user and therefore have not been saved in the URL personal databook collection object.** (Paragraph [0034], discloses returning a list of web pages related to the search term entered by the user, this would allow users to not only receive pages that have already been visited by them, but also pages that may be relevant but haven't been already visited.)

It would be obvious for someone with ordinary skill in the art at the time of the invention to combine the teachings of the cited references to implement **entering at least one search term in a search engine, selectively saving URL references that have been previously visited and presenting all search results that satisfy at least one search term including any URL references that satisfy the at least one search**

term but have not been previously visited by the user and therefore have not

been saved in the URL personal databook collection object because this would

allow users to not only receive pages that have already been visited by them, but also

pages that may be relevant but haven't been already visited.

With respect to claim 12:

Barrett teaches **loading the URL personal databook collection** (profile) **object**

(Column 7 Lines 26-28, discloses that the profile will processed therefore it had been

loaded) **in response to presenting the results from the search.** (Column 3 Lines 63-

65, discloses receiving results from a query executed by a user in a search engine)

With respect to claim 13, Barrett teaches:

Presenting any saved or captured comments (Column 8 Lines 56-57,

discloses that while presenting the information also statistics (applicant's comments will

be presented) **associated with any matches in response to positioning a computer**

pointing device on a selected visually identified match in the results from the

search, (Column 8 Lines 63-65, discloses that the access to the URLs is facilitated by

using mouse clicks) **wherein the saved or captured comments are presented on a**

page displaying the search results. (Column 8 Lines 56-57, discloses that while

presenting the information also statistics (applicant's comments will be presented)

With respect to claim 14:

Barrett teaches **selecting any results from the search containing content of interest for future reference in response to no matches; and** (Column 7 Lines 50-55, discloses that the pages stored in the profile (applicant's URL personal databook) are pages that have been previously visited by the user, therefore a user can add a web page to the profile by visiting the web page)

Storing any selected search results in the URL personal databook collection object. (Column 7 Lines 50-55, discloses that the selected by visiting URLs will be stored in the profile)

With respect to claim 15:

Barrett teaches **presenting a dialogue box to enter comments related to any stored search results; and** (Column 8 Lines 56-57, discloses that the information pertaining to statistics for each URL are shown, therefore it would be inherent that they would be stored)

Storing any comments in association with the stored search results. (Column 7 Lines 50-55, discloses that the selected by visiting URLs will be stored in the profile)

With respect to independent claim 16, Barrett teaches:

A system to identify a previously visited URL in results from a search, comprising:

A processor; (Column 5 Lines 48-52, discloses the use of a CPU)

An output device to present all search results that satisfy the at least one search term; (Column 8 Lines 52-56, discloses presenting to the user the URL results of previously visited sites)

A data structure operable on the processor to compare results from a network search by a search engine (Column 3 Lines 63-65, discloses receiving results from a query executed by a user in a search engine); to any URL references of previously visited URLs stored in a URL personal databook collection (profile) object; and (Column 7 Lines 57-65, discloses processing the profile to identify the previously visited URLs matching the search results)

A data structure operable on the processor to identify any matches between the results from the search and any URL references stored in the URL personal databook collection (profile) object. (Column 7 Lines 57-65, discloses processing the profile to identify the previously visited URLs matching the search results)

Barret doesn't appear to explicitly disclose entering at least one search term in a search engine, selectively saving URL references that have been previously visited and presenting all search results that satisfy at least one search term including any URL references that satisfy the at least one search term but have not been previously visited by the user and therefore have not been saved in the URL personal databook collection object.

Goldstein teaches entering at least one search term in a search engine (Paragraph [033], teaches entering a search term in a search engine) selectively

saving URL references that have been previously visited (Paragraph [0134],

discloses that a user will be able to selectively add previously visited web pages to their

favorites) **and presenting all search results that satisfy at least one search term**

including any URL references that satisfy the at least one search term but have

not been previously visited by the user and therefore have not been saved in the

URL personal databook collection object. (Paragraph [0034], discloses returning a

list of web pages related to the search term entered by the user, this would allow users

to not only receive pages that have already been visited by them, but also pages that

may be relevant but haven't been already visited.)

It would be obvious for someone with ordinary skill in the art at the time of the

invention to combine the teachings of the cited references to implement **entering at**

least one search term in a search engine, selectively saving URL references that

have been previously visited and presenting all search results that satisfy at least

one search term including any URL references that satisfy the at least one search

term but have not been previously visited by the user and therefore have not

been saved in the URL personal databook collection object because this would

allow users to not only receive pages that have already been visited by them, but also

pages that may be relevant but haven't been already visited.

With respect to claim 17:

Barrett teaches **a data structure operable on the processor to visually identify any matches in the results from the search.** (Column 8 Lines 54-56, discloses identifying the matches by presenting the URLs)

With respect to claim 18:

Barrett teaches **a data structure operable on the processor to present any saved or captured comments** (Column 8 Lines 56-57, discloses that while presenting the information also statistics (applicant's comments will be presented) **associated with any matches in response to positioning a computer pointing device on a selected visually identified match in the results from the search,** (Column 8 Lines 63-65, discloses that the access to the URLs is facilitated by using mouse clicks) **wherein the saved or captured comments are presented on a page displaying the search results.** (Column 8 Lines 56-57, discloses that while presenting the information also statistics (applicant's comments will be presented)

With respect to claim 19:

Barrett teaches **a data structure operable on the processor to select any results from the search containing content of interest for future reference in response to no matches.** (Column 7 Lines 50-55, discloses that the pages stored in the profile (applicant's URL personal databook) are pages that have been previously visited by the user, therefore a user can add a web page to the profile by visiting the web page)

With respect to claim 20:

Barrett teaches **comprising a data structure operable on the processor to store any selected search results in the URL personal databook collection** (profile) **object.** (Column 7 Lines 50-55, discloses that the selected by visiting URLs will be stored in the profile)

With respect to claim 21:

Barrett teaches **a data structure operable on the processor to store and comments in association with the selected search results.** (Column 8 Lines 56-57, discloses that the information pertaining to statistics for each URL are shown, therefore it would be inherent that they would be stored)

With respect to independent claim 28, Barrett teaches:

A computer-readable medium having computer executable instructions for performing a method comprising:

Presenting all search results that satisfy the at least one search term; (Column 8 Lines 52-56, discloses presenting to the user the URL results of previously visited sites)

Comparing the results from a network search by a search engine (Column 3 Lines 63-65, discloses receiving results from a query executed by a user in a search engine) **to any URL object references in a URL personal databook collection**

(profile) **object;** (Column 7 Lines 26-28, discloses that the profile (applicant's personal

databook collection) will processed and Column 7 Lines 57-65, discloses processing the

profile to identify the previously visited URLs matching the search results) **and**

Visually identifying any matches between the results from the search and

any URL object references of previously visited URLs in the URL personal

databook collection (profile) **object.** (Column 7 Lines 57-65, discloses processing the

profile to identify the previously visited URLs matching the search results)

Barret doesn't appear to explicitly disclose **entering at least one search term in**

a search engine, selectively saving URL references that have been previously

visited and presenting all search results that satisfy at least one search term

including any URL references that satisfy the at least one search term but have

not been previously visited by the user and therefore have not been saved in the

URL personal databook collection object.

Goldstein teaches **entering at least one search term in a search engine**

(Paragraph [033], teaches entering a search term in a search engine) **selectively**

saving URL references that have been previously visited (Paragraph [0134],

discloses that a user will be able to selectively add previously visited web pages to their

favorites) **and presenting all search results that satisfy at least one search term**

including any URL references that satisfy the at least one search term but have

not been previously visited by the user and therefore have not been saved in the

URL personal databook collection object. (Paragraph [0034], discloses returning a

list of web pages related to the search term entered by the user, this would allow users

to not only receive pages that have already been visited by them, but also pages that

may be relevant but haven't been already visited.)

It would be obvious for someone with ordinary skill in the art at the time of the

invention to combine the teachings of the cited references to implement **entering at**

least one search term in a search engine, selectively saving URL references that

have been previously visited and presenting all search results that satisfy at least

one search term including any URL references that satisfy the at least one search

term but have not been previously visited by the user and therefore have not

been saved in the URL personal databook collection object because this would

allow users to not only receive pages that have already been visited by them, but also

pages that may be relevant but haven't been already visited.

With respect to claim 29:

Barrett teaches **loading the URL personal databook collection** (profile) **object**

(Column 7 Lines 26-28, discloses that the profile will processed therefore it had been

loaded) **in response to presenting the results from the search.** (Column 3 Lines 63-

65, discloses receiving results from a query executed by a user in a search engine)

With respect to claim 30:

Barrett teaches **presenting any saved or captured comments** (Column 8 Lines

56-57, discloses that while presenting the information also statistics (applicant's

comments will be presented) **associated with any matches in response to**

positioning a computer pointing device on a selected visually identified match in the results from the search, (Column 8 Lines 63-65, discloses that the access to the URLs is facilitated by using mouse clicks) **wherein the saved or captured comments are presented on a page displaying the search results.** (Column 8 Lines 56-57, discloses that while presenting the information also statistics (applicant's comments will be presented)

With respect to claim 31:

Barrett teaches **selecting any results from the search containing content of interest for future reference in response to no matches; and** (Column 7 Lines 50-55, discloses that the pages stored in the profile (applicant's URL personal databook) are pages that have been previously visited by the user, therefore a user can add a web page to the profile by visiting the web page)

Storing any selected search results in the URL personal databook collection object. (Column 7 Lines 50-55, discloses that the selected by visiting URLs will be stored in the profile)

With respect to claim 32:

Barrett teaches **presenting a dialogue box to enter comments related to any stored search results;** (Column 8 Lines 56-57, discloses that the information pertaining to statistics for each URL are shown, therefore it would be inherent that they would be stored) **and storing any comments in association with the stored search**

results. (Column 7 Lines 50-55, discloses that the selected by visiting URLs will be

stored in the profile)

With respect to claim 33, Barrett teaches:

Presenting any reason why a selected URL was previously visited in

response to positioning a computer-pointing device on a selected match in the

results from the search, wherein the reason is presented on a page displaying the

search results. (Column 8 Lines 54-57, discloses presenting the statistics of each URL,

the presentation of the URL is based on this statistics)

Response to Arguments

Claim Rejections under 35 USC 102

Applicant's arguments with respect to the 35 USC 102 rejections have been

considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mariela D. Reyes whose telephone number is (571)

270-1006. The examiner can normally be reached on M - F 7:30- 5:00 East time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MR   Jun 06, 2007

MR

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